

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID R. JOHNSTONE

Appeal No. 1999-1764
Application No. 08/827,544^{1, 2}

ON BRIEF

Before CALVERT, COHEN, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1

¹ Application for patent filed March 28, 1997.

² A petition to make this application special (Paper No. 3) was granted (Paper No. 4).

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through 8, all of the claims remaining in the application.

Appellant's invention pertains to a mounting assembly. An understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the APPENDIX to the brief (Paper No. 19).

As evidence of obviousness, the examiner has applied the documents listed below:

Wilson	4,813,641	Mar. 21, 1989
Wolterstorff, Jr. 1989	4,825,515	May 2,
Irizarry	5,649,634	Jul. 22, 1997
		(filed Nov. 13, 1995)

The following rejections are before us for review.

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of Wolterstorff.

Claims 6 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of Wolterstorff, as applied to claims 1 through 5, further in view of Irizarry.

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The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 20), while the complete statement of appellant's argument can be found in the brief (Paper No. 19).³

In the brief (pages 2 and 3), appellant indicates that claims 1 through 8 stand or fall together. Consistent with this statement, we focus our attention, infra, exclusively upon independent claims 1 and 6, with the remaining dependent claims respectively standing or falling therewith.

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims 1 and 6, the first declaration of David R. Johnstone executed February 2, 1998,⁴

³ Receipt of the "NOTICE OF RECENT DECISION" (Paper No. 21) is acknowledged.

⁴ In paragraph 6 of this declaration, declarant indicates attendance at "two (2) trade shows" in 1996 where "the

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the second declaration of David R. Johnstone executed June 10, 1998, the applied patents,⁵ and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We reverse each of the examiner's rejections under 35 U.S.C. § 103.

Initially, we refer to appellant's statement in the specification (page 5) that an "important feature" of the toy, doll or stuffed creature mounting assembly is the use of a buckle part (buckle assembly), "like the buckle assembly in a

product" was displayed. Apart from the above information, we are not informed of any specific details relative to these trade shows; in particular, the dates thereof in 1996, of relevance to the public use and on sale provision of 35 U.S.C. § 102(b).

⁵ In our evaluation of the applied references, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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seat belt assembly in a vehicle." As further expressed by
appellant (specification, page 5),

In this way, the safety habit of buckling
up with a seat belt is reinforced when
buckling up a toy, doll, or stuffed
creature in the mounting assembly 10.

Each of independent claims 1 and 6 is drawn to a mounting
assembly for mounting a toy, doll or stuffed creature
comprising, inter alia, a suction cup, a strap, and a buckle
assembly for buckling the strap about a toy, doll, or stuffed
creature.

We turn now to the evidence of obviousness. This panel
of the board fully appreciates not only the teaching of each
applied document, but also the manner in which they are
applied by the examiner. However, as explained more fully
below, the difficulty we have with the rejection of
appellant's claims is that when we set aside in our minds
appellant's own disclosure in the present application, we
readily discern that the collective teachings themselves would
not have been suggestive of the mounting assembly now claimed.

The Wilson document addresses a device for attaching an object to a surface (Fig. 1). However, the focus of patentee Wilson (column 3) is upon a flexible resilient elongate member (bungee cord or stretch cord) which is attached to suction cup 32 (Figs. 2 and 3). The Wolterstorff reference is certainly representative of a safety buckle assembly. Nevertheless, absent appellant's own teaching and impermissible reliance upon hindsight, it is apparent to us that one having ordinary skill in the art would have had no reason to selectively choose a buckle and strap assembly from among the myriad available mechanical alternatives for attaching one member to another. Only appellant provides the motivation to make the specific selection of a buckle and strap assembly, i.e., to reinforce the safety habit of buckling up with a seat belt, as explained above. We also note that the patent to Irizarry does not overcome the discussed deficiencies of the Wilson and Wolterstorff references. Since the evidence before us does not establish a prima facie case of obviousness, we need not address appellant's submitted evidence of nonobviousness (secondary considerations), i.e., the respective Johnstone declarations.

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In summary, this panel of the board has:

reversed the rejection of claims 1 through 5 under 35
U.S.C. § 103(a) as being unpatentable over Wilson in view of
Wolterstorff; and

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reversed the rejection of claims 6 through 8 under 35 U.S.C.
§ 103(a) as being unpatentable over Wilson in view of
Wolterstorff and Irizarry.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge))
)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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Thomas R. Virgil
836 South Northwest Highway
Barrington, IL 60010